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EXAMINER	
SIGMOND, BENNETT M	

ART UNIT	PAPER NUMBER
3688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/978,170	ROSENBERG ET AL.	
	Examiner	Art Unit	
	BENNETT SIGMOND	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-11,13-15,17,18 and 22-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-11,13-15,17,18 and 22-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1, 2, 5 - 11, 13 - 15, 17, 18, and 22 - 30 are currently pending in the application and have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 5 - 11, 13 - 15, 17 - 18, 22, 24, 26, 27 and 29 - 30 are rejected pursuant to 35 USC § 103(a) as being unpatentable over U.S. Pub. 2003/0037068 A1 to Thomas et. al. published February 20, 2003 in view of U.S. Pat. 7,017,173B1 to Armstrong dated March 21, 2006 and filed March 30, 2000 (hereinafter, "Armstrong"). Note that Thomas claims domestic priority to Provisional Application 60/193,894 filed on March 31, 2000. As used herein, a reference to "Thomas" shall include the claim of priority to the foregoing Provisional Application, and a reference to "Thomas Prov" in a citation shall refer to that portion of the specification of the foregoing Provisional Application where the subject matter being discussed is disclosed.

4. Referring to **claim 1**, Thomas discloses **a method of displaying an ad on a video replay system** (Thomas at p. 1 [0011], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19). The method of Thomas comprises **on a display of the video replay system, displaying user selected program content stored at a storage medium of the video replay system** (Thomas at p. 3 [0037], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19), **while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action** (Thomas at p. 3 [0037], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19), **obtaining an ad** (Thomas at p.4 [0040] – [0044], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19) and **displaying the ad on the display of the video replay system instead of the user selected program content** (Thomas at p.4 [0040] – [0044], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19).

5. Thomas does not expressly disclose that **(the user action) comprises pressing a pause key,** or that **upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused**; and then **displaying the ad after the time delay has elapsed**.

6. Armstrong discloses a method and apparatus for inserting advertisements and/or other information into an audio-video presentation in response to a user's pressing a pause or stop button (Armstrong at C2, L11-23). Armstrong also discloses a delay following the user's pressing the pause or stop button, during

which time the subscriber equipment displays selected user program content as still imagery (Armstrong C3, L35-41). Armstrong further discloses that during the foregoing delay, while the user-selected content is showing, the user may select advertising for viewing and then view same (see Armstrong at C5, L62 – C6, L14, C12, L5-26). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of displaying an ad on a video replay system disclosed in Thomas with the use of a pause key, continued display of user-selected content during a delay following use of the pause key and display of the ad following the delay as disclosed in Armstrong. One having ordinary skill in the art would have recognized that the results of the combination were predictable.

7. **Claim 2** depends from claim 1, adding the limitation that the method allows a user to set the time delay. As mentioned above, Armstrong discloses a user's setting the time delay by deciding how long to pause before viewing an ad. (see Armstrong at C5, L62 – C6, L14, C12, L5-26). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method disclosed in Thomas with allowing the user to set the time delay as disclosed in Armstrong. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

8. **Claim 5** depends from claim 1, adding the limitation that the **ad is a commercial ad**. Thomas discloses the ad as being for a product (Thomas Prov. P. 4, L12-18) such as Calloway golf clubs (Thomas at P. 4 [0043]). Armstrong discloses a variety of commercial goods and services featured in the ads

(Armstrong at C5, L7-25). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method disclosed in Thomas and Armstrong in discussed in reference to claim 1 with the ad being a commercial ad as also disclosed in Thomas and Armstrong. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

9. Claims **6, 7, 8, 9, 10 and 11** each depends from claim 1. Each adds a limitation pertaining to the nature of the ad referenced in claim 1. **Claim 6** specifies that **the ad is a user-selected picture**. Armstrong discloses that the user may select the ad (see Armstrong at C5, L62 – C6, L14, C12, L5-26). In fact, Armstrong discloses that the ad "simply comprises an information bearing file" (Armstrong at C3, L17-18). **Claim 7** specifies that **the ad is a user-selected still photograph**. Armstrong discloses that the ad may be still or moving imagery (C3, L4-17) which the user selects (C5, L62 – C6, L14, C12, L5-26). **Claim 8** specifies that **the ad is a user-selected video clip.** Armstrong also discloses that the ad may be a video clip (see also, C8, L3-20) that the user selects (C5, L62 – C6, L14, C12, L5-26). **Claim 9** specifies that the ad is a **still commercial ad**. The disclosure of Armstrong cited in reference to claim 7 also discloses this limitation. **Claim 10** specifies that the ad is a **commercial ad containing a video clip**. Armstrong also discloses that the secondary content, including the ad, may be a video clip (see Armstrong at C3, L4-17). Finally, **claim 11** specifies that **the ad is a video animation**. Thomas discloses that the pause-time ad may be a

video animation (see Thomas Prov. at p.2, L18-22, Thomas at p. 1 [0011] and p. 6 [0057]), which of course, also qualifies as a video clip.

10. In combination, Thomas and Armstrong disclose each of the limitations added to claim 1 by dependent claims 6 – 11, respectively. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the methods disclosed in Thomas and Armstrong including the various types of ads disclosed in Thomas and Armstrong. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

11. **Claims 13, 14 and 15** each depends from claim 1, adding an additional limitation as to the source of the ad referenced in claim 1. **Claim 13** adds the limitation that **the ad is obtained from an "ad placement engine"**. Giving the foregoing term its broadest reasonable interpretation consistent with the specification *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005), MPEP 2111, "ad placement engine" is interpreted to encompass a database application that places ad with a user. Armstrong discloses a database application that stores data concerning ads available to be viewed and assists in the selection of ads (see C4, L63 – C5, L62). **Claim 14** specifies that **the ad is obtained from external storage**. Armstrong discloses that ads may be obtained from an advertiser's web site (see C4, L63-67). External storage is inherent in delivery of ad content via a third party web site. **Claim 15** specifies that the ad is downloaded from a computer connected to the video replay system. Interpreting "connected" to include connected via the Internet, Armstrong discloses this limitation as well ***(id)***.

12. In combination, Thomas and Armstrong disclose each of the limitations that 13 – 15 add to claim 1. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the methods disclosed in Thomas and Armstrong as discussed in reference to claim 1 and include in the combination, the various sources of ads also disclosed in Armstrong. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

13. **Claims 17 and 18** depend from claim 1 and add limitations based on the size of the ad. **Claim 17** specifies that **the ad is a full-page ad**, which the specification defines as occupying the entire display. Armstrong discloses that in one embodiment, the ad comprises the entire display window (see C10, L28-35). **Claim 18** specifies that **the ad occupies less than all of the display**. Armstrong discloses another embodiment comprising a split screen with part of the screen devoted to the ad and another part of the screen devoted to a frozen frame of the previously displayed user content (see Fig,. 4, C9, L27 – 38).

14. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the methods disclosed in Thomas and Armstrong as discussed in reference to claim 1 and include in the combination, the various sizes of the displays of ads also disclosed in Armstrong. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

15. **Claim 22** depends from claim 1, adding the limitation that **the pause key is on the video replay system**. **Claim 24** depends from claim 1, adding the

limitation that **the pause key is on a remote control**. Armstrong discloses the pause key as being on a remote control (see C2, L14-22) which is part of the video replay system (see Fig. 1, item 146, C3, L57 – C4, L2). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the methods disclosed in Thomas and Armstrong as discussed in reference to claim 1, and include the pause key being on a remote control device that is part of a video replay system as disclosed in Armstrong. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

16. **Claims 26 and 27** also depend from claim 1. Claim 26 adds the limitation that **the user selected program content comprises a selected television program**. Thomas discloses the user selected content being a television program (see Thomas Prov. at p. 1, L17-19, Thomas at P. 1 [0003]).

17. **Claim 26** also adds the limitations that the method further comprises, **prior to displaying the user selected program content: (i) receiving the selected television program content at the video replay system; and (ii) storing the selected television program content at the storage medium of the video replay system**. Thomas discloses these additional steps as television programming is the principal medium in which the invention of Thomas is disclosed (see Thomas Prov. at p. 1, L7 - p. 2, L17, Thomas at p. 1 [0003]-[0004]).

18. **Claim 27** adds the limitation that **the display of the video replay system comprises a television set**. As discussed in reference to claim 26, Thomas

discloses this limitation as television programming is the principal medium in which the invention of Thomas is disclosed (see Thomas Prov. at p. 1, L7 - p. 2, L17, Thomas at p. 1 [0003]-[0004]).

19. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the methods disclosed in Thomas and Armstrong as discussed in reference to claim 1 and include in the combination, receiving, storing and displaying television program via the video replay system as disclosed in Thomas. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

20. Referring to independent **claim 29**, Thomas discloses **a method of displaying an ad on a video replay system** (Thomas at p. 1 [0011], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19), the method comprising **obtaining an ad** (Thomas at p.4 [0040] – [0044], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19), **on a display of the video replay system, displaying a video stream stored at a storage medium of the video replay system** (Thomas at p. 3 [0037], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19), **while the video stream is being displayed on the display of the video replay system, entering a pause mode** (Thomas at p. 3 [0037], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19), and **upon entering pause mode, displaying the ad on the display of the video replay system instead of the video stream** (Thomas at p.4 [0040] – [0044], Thomas Prov. at p.2, L18 – p.3, L2, p.5, L9-19).

21. Thomas does not explicitly disclose **during a time delay greater than zero seconds, continuing to display the video stream on the display of the**

video replay system, wherein the video stream displayed during the time delay is paused, or that **the ad is displayed after the time delay has elapsed.** However, as discussed above in reference to claim 1, Armstrong discloses a delay following the user's pressing a pause or stop key, during which time the subscriber equipment displays selected user program content as still imagery (Armstrong C3, L35-41). Armstrong also discloses that during the foregoing delay, while the user-selected content is displayed, the user may select advertising for viewing and then view same, controlling the time delay in between pausing and display of the ad content (see Armstrong at C5, L62 – C6, L14, C12, L5-26) in full-page mode (Armstrong at C10, L28-35).

22. **Claim 30** depends from claim 29, adding the limitation that **wherein the pause mode is entered in response to a user action that comprises pressing a pause key.** As discussed in reference to claim 1, Armstrong discloses that pause mode is entered in response to a user pressing a pause key (Armstrong at C2, L11-23).

23. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of displaying an ad on a video replay system including entering pause mode after a user presses a pause key as disclosed in Thomas with the continued display of user-selected content during a delay following entry of pause mode and display of the ad following the delay as disclosed in Armstrong. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

24. **Claim 23** is rejected pursuant to 35 USC § 103(a) as being unpatentable over Thomas in view of Armstrong and U.S. Pat. 7,225,142 B1 to Apte, et. al (hereinafter, "Apte"), issued May 29, 2007 but filed August 1, 1996. Claim 23 depends from claim 1, adding the limitation that **the pause key is on the display of video replay system**. Neither Thomas nor Armstrong explicitly discloses that the pause key is on the display.

25. Apte discloses a method and system for providing targeted interactive multimedia advertisements (C3, L33-41) in which the user may pause the advertisement by pressing a pause button located on the display device (C6, L17-25, Fig. 5, pause button 40). It would have been obvious to one having ordinary skill in the art at the time of the invention to substitute the pause button on the display of the video replay system as disclosed in Apte for the pause button on a remote control as disclosed in Armstrong and one having ordinary skill in the art at the time of the invention would have recognized the results to have been predictable.

26. **Claims 25 and 28** are rejected pursuant to 35 USC § 103(a) as being unpatentable over Thomas in view of Armstrong and U.S. Pat. 6,332,127 B1 to Bandera, et. al. (hereinafter, "Bandera"), issued December 18, 2001 and filed January 28, 1999.

27. **Claim 25** depends from claim 1, adding the limitation that **the video replay system is a handheld video player. Claim 28** also depends from claim 1, adding the limitation that **the display of the video replay system comprises**

a cellular device. Neither Thomas nor Armstrong expressly discloses a hand held video player or a cellular device as the video replay system.

28. Bandera discloses systems and methods for presenting advertisements to users of the Web via mobile Web clients such as personal digital assistants (PDAs) and cellular telephones (see C2, L19-34). Thus, Bandera discloses presentation of advertising content to handheld video players and cellular devices as the display of the video replay system. It would have been obvious to one having ordinary skill in the art at the time of the invention to substitute PDAs and cellular telephones as video replay devices as disclosed in Bandera for the television screen disclosed in Thomas and Armstrong, and one having ordinary skill in the art at the time of the invention would have recognized the results to have been predictable.

Response to Applicant's Arguments

29. Applicant's arguments with respect to the claimed invention have been considered, but are moot in view of new grounds of rejection.. However, due to the introduction of new grounds of rejection, this office action is Non-Final.

Conclusion

The prior art made of record and not relied upon that is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited. U.S. Pat 5,884,141 to Inoue et. al. discloses the display of original content following entry of a pause mode. U.S. Pub 2002/0036655 to

Yulevich et. al. discloses a method for displaying user-selected advertising during a period of inactivity on a computing device. U.S. Pat. 5,740,549 to Reilly discloses an information and advertising distribution system which delivers customized banner ads and screen savers./B. S./

Examiner, Art Unit 3688 U.S. Pat 6,349,410 to Lortz discloses coordination of the display of an incoming signal stream such as TV broadcasting or streaming web content. U.S. Pat 5,959,621 to Nawaz et. al. discloses a system and method for dynamically displaying data including advertising on a client computer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENNETT SIGMOND whose telephone number is (571) 270-3414. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. S./

Examiner, Art Unit 3688

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3688